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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,918	07/03/2003	Takashi Igarashi	108833.01	5605
25944	7590	11/18/2009		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER SHAKERI, HADI	
			ART UNIT 3727	PAPER NUMBER
			MAIL DATE 11/18/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/611,918	<b>Applicant(s)</b> IGARASHI ET AL.	
	<b>Examiner</b> HADI SHAKERI	<b>Art Unit</b> 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/787,014.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the table including a turning speed of the revolving machining tool and a turning speed of the held plastic lens and a number of revolution of the plastic lens; rows indicating the turning speed of the held lens, thickness of the plastic lens; columns indicating the kind of machining and a number of revolutions of the lens must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 5 is finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 5 as amended recites for rows to include a first division for each number of revolutions of the lens, corresponding to the type of material, whereas specification as originally filed, e.g., in paragraph 0170, describe for the column to include these data, further Fig. 24 indicates for the rows to show the type of machining, e.g., circumferential surface rough machining, fine machining, etc., whereas claims as amended now recite for the columns to indicate these values.

Further with regards to claim 5, the recitation that a number of revolutions of the plastic lens is calculated based on... renders the claim indefinite. Specification as originally filed defines "setting" values like feed speed, tool, speed, number of revolution of the lens and by changing these parameters according to the material and power of the lens, the shape and size could be uniformly finished (see e.g., paragraph 165); and that by changing these parameters according to the type of machining, finished surfaces can be made in good fashion (paragraphs 166, 179). It is unclear what is being claimed by reciting the number...is calculated? Applicant is required to clarify and point out the support. Rejection under 112, first paragraph is not applied at this time, since the deficiencies appear to be of clarity rather than enablement.

**Claim Rejections - 35 USC § 103**

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claim 5 (as best understood) is finally rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-016346.

JP'346 meets all of the limitations of claim 5, i.e., a method of rough machining and finish machining (see Abstract) in which cutting speed (revolution of lens as best understood), feed amount (feed speed), and a material (e.g., plastic as commonly used in the art) to be machined are inputted to an NC device for different type of machining (rough and finish machining disclosed) and a table comprising rows and columns would indicate the cutting speed and a feed rate of the tool and a tool feed speed (i.e., lens holding shaft turning speed and thus the number of revolution of the workpiece or number of revolution of the plastic lens for a particular size and shape) for either or both rough and fine machining based on the inputted variables, except for explicitly disclosing groove engraving and chamfering, considered to be obvious modifications to one of ordinary skill in the art for adapting the method and the table to output values for grooving and chamfering. The table as disclosed includes a column for the type of the work, e.g., a material to be cut (see Abstract), but it does not appear to disclose the thickness of the lens, however, one of ordinary skill in the art would have known that desired finish and/or rough machining would directly depend on the thickness of the work, or the

Figure 11a and 11b are tables showing machining parameters. Table 11a has columns for work type (W1, W2, W3) and tool type (T1, T2, T3). Table 11b has columns for work type (W1, W2, W3) and tool type (T1, T2, T3). Both tables show values for cutting speed (V) and feed rate (S) for each combination of work type and tool type.

	T1	T2	T3
W1	V	V	V
W2	S	S	S
W3	V	V	V
	S	S	S

	T1	T2	T3
W1	V	V	V
W2	S	S	S
W3	V	V	V
	S	S	S

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amount to be abraded, therefore it would have been obvious to one of ordinary skill in the art to modify the table to further include the thickness of work in addition to the material to be cut in achieving the desired results, e.g., in abrading a plastic lens commonly used.

7. Claim 5 (as best understood) is finally rejected under 35 U.S.C. 103(a) as being unpatentable over JP 64-016346 in view of Woods (5,053,971).

JP`346 as described above meets all of the limitations of claim 5, except for disclosing groove engraving and chamfering and the thickness of the lens. Woods teaches chamfering or beveling lens in which proper speed and feed rate are set based on the material selected (10:28) and thickness (04:45-55). It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to modify the invention of JP`346 with additional variables, e.g., thickness as taught by Woods to adapt the method for operations like chamfering, grooving, etc.

### ***Response to Arguments***

8. Applicant's arguments filed July 14, 2009 have been fully considered but they are not persuasive.

With regards to the drawings objection, Applicant indicates that Fig. 24 shows a turning speed of the revolving machining tool (e.g., Tool Turning Speed), with rows indicating the turning speed of the les held (e.g., lens shaft truing speed); however, this is no persuasive, since claim 5, in lines 11 and 12, recites for a table "including a turning speed of the revolving machining tool, a turning speed of the held plastic lens and a

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number of revolution of the plastic lens", therefor if Tool Turning Speed indicates the turning speed of the revolving machine tool, and Lens Shaft Turning Speed indicates the turning speed of the lens held, what then, indicates the a number of revolution of the plastic lens in Fig. 24?

Applicant further indicates that rows have a first division (annotated Fig. 24) that indicate thickness of the plastic lens (e.g., Thick, Thin), which is not persuasive, since Thick or Thin does not indicate a thickness; further Thick and Thin define columns and not rows.

Applicant's argues with regard to the rejection of claims under 112, second paragraph that the rejection appears to be of enablement and that examiner gives no reasons as to why the claim is indefinite. This argument is in error, since claim 5 has been amended to read over prior art applied, and claim recites features not clearly defined by the specification as originally filed, and as was indicated in the office action, the deficiencies appears to be of clarity and not of enablement. Applicant's explanation of how columns and rows meet the recited features and/or how column and rows may be defined, does not overcome the deficiencies. Applicant further argues that specification indicates that the number of revolutions of a plastic lens, "y", can be calculated, whereas the claim recites, in lines 10-13, to forcible edging using...a number of revolution of the plastic lens, from a table previously prepared. The claim as recited is still considered to be indefinite for failing to clearly recite the elements and features being claimed.

The argument that Satoru does not disclose the columns in the table as recited, and that it does not disclose the number of revolution of the lens based on the type of material is not persuasive, because of the indefiniteness it is unclear what the scope of invention is, and the features of the claimed invention as best understood are met by modified Satoru. Both Satoru and Woods are concerned with uniform finish of the workpiece by controlling and setting several parameters like, the number of revolution of the lens, the thickness of the lens and the type of material of the lens. Therefor Satoru and Satoru modified by Woods are considered to provide sufficient support and suggestions to enable one of ordinary skill in the art to meet the claims (as best understood).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hadi Shakeri whose telephone number is 571-272-4495. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica S. Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 16, 2009

/Hadi Shakeri/  
Primary Examiner, Art Unit 3727